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Supreme Court, U.S.
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No. 04-1369

IN THE

Supreme Court of the United States

JAMES R. EDDINGS, GALT MEDICAL CORPORATION, and XENTEK MEDICAL INC.,

Petitioners,

v.

LARRY G. JUNKER,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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STATEMENT OF THE CASE

Throughout the district court proceedings, Junker contended that the scope of his D'839 design patent claim included ornamental features of the depicted introducer sheath, namely, the size and shape of the enlarged, rounded, "Mickey Mouse ear" shaped handle. Junker presented evidence at trial relating to those features, for which he contended that he was first to invent. The defendants (collectively referred to as "Galt" or "Petitioners") maintained throughout the lawsuit that the design patent showed only functional features and no ornamental features. The entire trial was centered on Junker's asserted features and patent law issues relating to them.

Jury instructions and questions were discussed with the district court just prior to each party presenting Rule 50(a) motions. Without objection, the court proposed a single jury question covering all of Galt's 35 U.S.C. §102 defenses. In doing so, the court properly construed the claim to include the ornamental features of the patent. Galt did not object to the jury instructions or to the jury question relating to claim construction or invalidity. Galt never request additional specificity, or that particular features be included in a claim construction, though Galt, as the party challenging validity, had the burden to do so by clear and convincing evidence.

Regarding claim construction, Galt pleaded that the design patent was invalid based upon the argument that the design was entirely functional under 35 U.S.C. §171, i.e., showed no ornamental features, a claim that Galt lost on Junker's motion for summary judgment when Junker presented evidence on the key ornamental features asserted throughout the case. Even though Galt presented no evidence

or argument to rebut Junker's summary judgment motion that the patent was not invalid due to functionality, Galt continued to maintain as late in the proceedings as Jury Charge discussions, just prior to making its Rule 50(a) motion, that the patent showed no ornamental features. Petitioners at that time argued to the district court that "[defendants] maintain there is [no] design invention here." See Federal Circuit Appeal Nos. 04-1208; -1271 Joint Appendix p. A1002, transcript page 35, lines 11-13.

Before the case was submitted to the jury, Galt moved for judgment as a matter of law (JMOL) pursuant to Rule 50(a) of the Federal Rules of Civil Procedure. Galt contended that the claim of the D'839 patent was invalid under 35 U.S.C. §102(e) based on the earlier filing date of a utility patent, the '914 patent, but failed to identify any of the features they asserted were ornamental to the appellate court. The trial court denied Galt's motion without prejudice to its renewal.

The jury found that Galt had not proven the patent invalid by clear and convincing evidence. Post-verdict, Galt renewed its motion for JMOL that the D'839 patent was invalid in accordance with Rule 50(b), and the court again denied it.

On appeal, the Court of Appeals for the Federal Circuit agreed with Junker that Galt's JMOL motions did not adequately raise the issue, held that Galt therefore could not on appeal press the contention, and affirmed the district court's ruling.

In so affirming the district court, the Federal Circuit reviewed Galt's Rule 50(a) motion. The Federal Circuit found that the motion referred to the subject matter claimed in the D'839 patent in general terms, such as the "design claimed in the patent." At trial, Junker introduced evidence on the

ornamental features that he claimed to have invented, the enlarged "Mickey Mouse ear" shape of the handle. Galt's appeal argument of invalidity, however, was based upon specific additional features of the design, such as its upswept appearance and rounded side edges, which Galt for the first time on appeal contended were ornamental, though there was evidence at trial that theses features were functional. The appellate court concluded that the general statements in Galt's original JMOL motion were inadequate to inform either Junker or the district court that Galt's challenges to the validity of the D'839 patent involved the specific elements of the design.

Galt then filed its petition for writ of certiorari.

REASONS FOR DENYING THE PETITION

Contrary to Petitioners' assertions, and contrary to Fed. R. Civ. P. Rule 50(a), the Petitioners' Rule 50(a) motion 1) set out incorrect law, 2) failed to set out the law upon which the motion was based, and 3) failed to set out the facts upon which the motion was based.

Further, the Federal Circuit 1) stated correctly the law as it relates to Rule 50(a), 2) is not in conflict with any other circuit's law regarding Rule 50(a), 3) applied the correct law consistently in relation to other Rule 50(a) cases before it, and 4) applied the facts of the case to the properly stated law.

Petitioners simply have a view of the facts different from the District Court and from the Federal Circuit.

1. The Petition Does Not Meet the Considerations Governing Review on Certiorari

Supreme Court Rule 10 ("SCR 10") sets forth the considerations governing review on certiorari. Petitioners have not met any subsection of SCR 10 (a)-(c), nor have they set forth an argument that the issue presented is of a compelling nature or similar character as those set forth in SCR 10. To the contrary, the petition falls squarely within the SCR 10 guidelines for the rare grant of a writ of certiorari, i.e., a "properly stated rule of law," regardless of the correct or erroneous factual findings or the misapplication of the properly stated law.

a. The Appellate Court Properly Stated the Rule of Law

The Federal Circuit properly stated the rule of law in connection with Rule 50(a):

> Rule 50(a) provides that a motion for JMOL made before the case is submitted to the jury "shall specify . . . the facts on which the moving party is entitled to the judgment." Fed. R. Civ. P. 50(a)(2). Therefore, Galt's Rule 50(a) oral motion had to be sufficiently specific regarding its factual basis to inform Junker of exactly what Galt alleged to be deficient in Junker's evidence, thus giving Junker an opportunity to cure the defects in proof. *See Gaus v. Conair Corp.*, 363 F.3d 1284, 1287 (Fed. Cir. 2004); *Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098, 1106 (Fed. Cir. 2003). The specificity requirement serves the further important purpose of informing the trial court of

> the precise issues it must decide in ruling on the motion. *See*, e.g., *Gordon v. County of Rockland*, 110 F.3d 886, 887 (2d Cir. 1997); *Clark v. Cent. States Dredging Co.*, 430 F.2d 63, 65 (8th Cir. 1970); *see also* 9 James W. Moore *et al.*, Moore's Fed. Practice P 50.02[3] (3d ed. 1997). The issue here "pertains uniquely to patent law" in that it concerns specific features of a design patent and therefore, we review the district court's determination under Federal Circuit law. *Duro-Last*, 321 F.3d at 1106.
>
> To be sure, "courts may excuse a party's failure to comply with the technical requirements of Rule 50 if the party clearly challenged the sufficiency of the evidence on the disputed issue at some point during trial, thereby alerting the opposing party as to the grounds on which the evidence is allegedly insufficient." *Duro-Last*, 321 F.3d at 1106; *cf. Gaus*, 363 F.3d at 1287-88 (party had notice of claim construction issue on appeal where opponent had made similar argument before trial).

369 F.3d at 1363-64.

Petitioners have not challenged the Federal Circuit's correctly stated Rule 50(a) law. Accordingly, the petition should be denied.

b. There is No Circuit Split On The Question Presented, Nor is There Conflict in the Federal Circuit's Previous Opinions

In each case cited by Petitioner, the Federal Circuit applied the properly stated rule of law to the facts of the case to determine if the Rule 50(a) motion was sufficiently specific in light of the challenges made during trial to inform the opposing party and the district court of exactly what evidence was alleged to be insufficient so as to allow an opportunity to cure the defects in proof — the same law as was applied in the instant case. There is nothing inconsistent that under the facts of one case, the Federal Circuit's application of Rule 50(a) lead to one conclusion, while under the facts of another case, the appellate court reached a different conclusion.

2. Petitioners' Assertion That They Literally Complied With Fed. R. Civ. P. Rule 50(a) Is Incorrect

a. Petitioners Did Not Set Forth The Facts Upon Which They Were Entitled To The Judgment

Petitioners based their appeal argument before the Federal Circuit on the premise that the claim of the design patent included ornamental features such as upswept wings, symmetrical ridges, and rounded distal edges. Contrary to the requirements of Rule 50(a), however, these appeal-asserted ornamental features were never set out at the district court. Petitioners never argued these were ornamental features before the district court. To the contrary, the defendants asserted that there was **no design invention**, i.e., maintained that the design patent was invalid because it showed entirely functional features, even as late as the jury

charge discussion, immediately before making their Rule 50(a) motion. See Federal Circuit Appeal Nos. 04-120, -1271, Joint Appendix at page A1002, transcript page 35, lines 11-13, wherein Galt's counsel argued:

> . . . Mr. Eddings and Mr. Gillespie don't maintain there is a design invention here.

b. Petitioners Did Not Set Forth The Law Upon Which They Were Entitled To The Judgment

Petitioners based their argument before the Federal Circuit and before this Court on the premise that a design patent claim should be construed to include all elements of the patent drawings shown in solid lines and cited several cases for the proposition. Though Respondent believes this is an incorrect statement of the law as applied to the instant case, it was from that law Petitioners argued to the appellate court that their Rule 50(a) motion should have been interpreted by the district court to include all elements in solid lines. In violation of Rule 50(a), however, Petitioners never cited that law regarding construction of design patent claims to the district court. Through pleadings, Summary Judgment motions, jury charge arguments, etc., Petitioners instead maintained that there was no design feature shown in the patent, and never moved the court for, or objected to the district court's claim construction beyond that given by the district court in the Jury Instructions. It was for the first time on appeal that the Petitioners asserted a claim construction based on never cited law.

Indeed, the district court did precisely what Petitioner's case law dictates and construed only those claim issues that were in dispute. The only features considered throughout the trial were the ornamental features asserted by Respondent.

Gaus v. Conair Corp., 363 F.3d 1284 (Fed. Cir. 2004), cited by Petitioners as requiring little detail in a Rule 50(a) motion is completely inapposite and supports Respondent's position. In that case, the key issue was well known throughout the litigation and further specificity was unnecessary. Here, in contrast, further specificity was required to the extent Petitioners expected their Rule 50(a) motion to extend beyond the ornamental features on which the case focused.

c. Petitioners Did Not Set Forth The Correct Law Upon Which They Were Entitled To Judgment

Petitioners argued in their Rule 50(a) motion to the district court that once they showed a patent with a filing date earlier than the asserted patent under section 102(e), that Junker then was "in a position of a prior inventor, and he bears the burden of evidence on this point, which must be clear and convincing . . .". see Petitioners' Appendix C at 28a-29a. In so doing, Petitioners cited "*Cooper v. Goldfarb* 154 F.3d 1321," a case involving an appeal from an interference proceeding before the Patent Office, a case having nothing to do with section 102(e). Contrary to the Petitioners' citation, it is clear law that the challenger to a patent bears the burden by clear and convincing evidence.

Because the Petitioners failed to set forth the facts and the law upon which they based their Rule 50(a) motion, and because they set forth the wrong law, the Federal Circuit properly affirmed the district court's denial of their Rule 50(a) motion, and this court should likewise deny their petition for writ of certiorari.

PETITIONERS' MISSTATEMENTS OF FACT AND LAW

Pursuant to Supreme Court Rule 15.2., if certiorari were granted, Respondent identifies Petitioners' misstatements of fact and law in addition to those discussed above.

Petitioners misstate that the design patent at issue had many ornamental features. Petition at page 4.

Petitioners misstate that they argued the patented design incorporated numerous ornamental features, to the extent Petitioners assert such was argued at the district court. Petition at page 4.

Petitioners misstate that all elements shown in solid lines in a design patent drawings are ornamental features to be included in a claim construction. Petition at page 5.

Petitioners misstate that panel decisions of the Federal Circuit and regional circuits have been inconsistent in application of Rule 50(a). Petition at page 2.

Petitioners misstate that Respondents could only corroborate one ornamental feature of the design patent, rather than multiple features. Petition at page 7, footnote 8.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be denied.

Respectfully submitted,

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